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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/827,566	04/19/2004	Virinder Mohan Batra	CHA920040004US1	3188
23550 7590 09/24/2008 HOFFMAN WARNICK LLC 75 STATE STREET 14TH FLOOR ALBANY, NY 12207				
EXAMINER GORTAYO, DANGELINO				
ART UNIT 2168		PAPER NUMBER		
NOTIFICATION DATE 09/24/2008		DELIVERY MODE ELECTRONIC		

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

PTOCommunications@hoffmanwarnick.com

### Office Action Summary

**Application No.**

10/827,566

**Applicant(s)**

BATRA ET AL.

**Examiner**

DANGELINO N. GORTAYO

**Art Unit**

2168

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 29 July 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-20 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SF/ICE)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

## **DETAILED ACTION**

### ***Continued Examination Under 37 CFR 1.114***

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 7/29/2008 has been entered.

### ***Response to Amendment***

2. In the amendment filed on 7/29/2008, claims 1, 8, and 16 have been amended. The currently pending claims considered below are Claims 1-20.

### ***Claim Rejections - 35 USC § 112***

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claims 1, 8, and 16 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 1 recites the limitation "capable of" in line 13. The resulting claim does not clearly set forth the metes and bounds of the patent protection desired. See MPEP §

2173.05(c), since the claim appears to cover anything and everything that does not prohibit the stated limitation from occurring. Proper correction is required.

Claim 8 recites the limitation "capable of" in line 11. The resulting claim does not clearly set forth the metes and bounds of the patent protection desired. See MPEP § 2173.05(c), since the claim appears to cover anything and everything that does not prohibit the stated limitation from occurring. Proper correction is required.

Claim 16 recites the limitation "capable of" in line 12. The resulting claim does not clearly set forth the metes and bounds of the patent protection desired. See MPEP § 2173.05(c), since the claim appears to cover anything and everything that does not prohibit the stated limitation from occurring. Proper correction is required.

### ***Claim Rejections - 35 USC § 101***

5. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

6. Claims 1-20 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

For an invention to be statutory, an invention must disclose a "useful, tangible, and concrete result". The claimed invention as a whole must be useful and accomplish a practical application. That is, it must produce a "useful, concrete and tangible result."

State Street, 149 F.3d at 1373-74, 47 USPQ2d at 1601-02. The purpose of this requirement is to limit patent protection to inventions that possess a certain level of "real world" value, as opposed to subject matter that represents nothing more than an idea or

concept, or is simply a starting point for future investigation or research (Brenner v. Manson, 383 U.S. 519, 528-36, 148 USPQ 689, 693-96 (1966)); In re Fisher, 421 F.3d 1365, 76 USPQ2d 1225 (Fed. Cir. 2005); In re Ziegler, 992 F.2d 1197, 1200-03, 26 USPQ2d 1600, 1603-06 (Fed. Cir. 1993)).

Independent claims 1, 8, and 16 recite the limitation "capable of". The claims fail to produce a useful, concrete, or tangible result, since the claims are absent a recitation of any code or step configured for causing a computer to do anything, and instead just insures that no code or step prohibits the limitation. Proper correction is required.

***Claim Rejections - 35 USC § 102***

7. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

8. Claims 1-6, 8-14, 16-18, and 20 are rejected under 35 U.S.C. 102(b) as being anticipated by Farmer (WO 02/39486)

**As per claim 1,** Farmer teaches "A system for dynamically implementing a chain of Web services from a client on the World Wide Web to execute a workflow for analyzing microarray data," (see Abstract and paragraph 0008)

"comprising: a database for storing a list of available Web services, wherein each listed Web service includes a description of a task performed by the Web service and

an input signature and an output signature of the Web service, wherein the Web service comprises a computer program accessible over the World Wide Web;" (Figure 3, paragraphs 0018, 0022, 0022, 0051, 0057, 0058, 0062, wherein a Service Broker accepts requests and provides connections to services, and contains service names, types, and attributes in Java class format, including type signatures)

"and a selecting system for forming the chain of Web services by selecting a Web service from the list of available Web services for each of a plurality of tasks in the workflow," (Figure 11, paragraphs 0040, 0053, 0060, 0061, 0062, 0063, wherein services can be linked together and service attributes and classes are used for interaction)

"wherein the workflow comprises a series of linked tasks and a specified input and output format," (Figure 3, paragraphs 0040, 0042, 0043, 0045, 0046, 0053, 0062, wherein services interact and identify with each other through java classes, and are encapsulated to interact with each other, including formats defined by type signatures)

"wherein the selecting system examines a set of available Web services capable of completing each task and identifies at least one Web service having matching input and output signatures ensuring that each Web service selected to complete a task is compatible with adjacent Web services in the chain of Web services" (Figure 3, Figure 11, paragraphs 0022, 0036, 0041, 0043, 0046, 0048, 0049, 0056, 0057, 0058, 0061, 0070, 0071, 0074-0079, wherein services are provided by service providers, and a client can utilize dynamic discovery to identify services that can recognize the data type to complete the service, to integrate heterogeneous data components and services).

**As per claim 2, Farmer** teaches "the workflow comprises a microarray analysis workflow." (Figure 2, paragraphs 0049, 0086)

**As per claim 3, Farmer** teaches "a workflow generator for creating the workflow." (paragraphs 0049, 0050)

**As per claim 4, Farmer** teaches "the list of available Web services resides locally with the client." (paragraphs 0039, 0044)

**As per claim 5, Farmer** teaches "a system for collecting and storing available Web services data." (paragraphs 0018, 0022)

**As per claim 6, Farmer** teaches "a system for inputting sequence data into the workflow execution." (paragraph 0067)

**As per claim 8, Farmer** teaches "A program product, stored on a recordable medium for executing a workflow by dynamically implementing Web services from a client on the World Wide Web for analyzing microarray data," (see Abstract and paragraph 0008)

"comprising: means for storing a list of available Web services, wherein each listed Web service includes a description of a task performed by the Web service, and an input signature and an output signature of the Web service;" (Figure 3, paragraphs 0018, 0022, 0022, 0051, 0057, 0058, 0062, wherein a Service Broker accepts requests and provides connections to services, and contains service names, types, and attributes in Java class format, including type signatures)

"and means for forming a chain of Web services by selecting a Web service from the list of available Web services for each of a plurality of tasks in the workflow," (Figure 11, paragraphs 0040, 0053, 0060, 0061, 0062, 0063, wherein services can be linked together and service attributes and classes are used for interaction)

"wherein the workflow comprises a series of linked tasks and a specified input and output format," (Figure 3, paragraphs 0040, 0042, 0043, 0045, 0046, 0053, 0062, wherein services interact and identify with each other through java classes, and are encapsulated to interact with each other, including formats defined by type signatures)

"wherein the forming means examines a set of available Web services capable of completing each task and identifies at least one Web service having matching input and output signatures ensuring that each Web service selected to complete a task is compatible with adjacent Web services in the chain of Web services" (Figure 3, Figure 11, paragraphs 0022, 0036, 0041, 0043, 0046, 0048, 0049, 0056, 0057, 0058, 0061, 0070, 0071, 0074-0079, wherein services are provided by service providers, and a client can utilize dynamic discovery to identify services that can recognize the data type to complete the service, to integrate heterogeneous data components and services).

**As per claim 9, Farmer** teaches "the workflow comprises a microarray analysis workflow." (Figure 2, paragraphs 0049, 0086)

**As per claim 10, Farmer** teaches "the workflow comprises a bioinformatics workflow." (paragraphs 0008)

**As per claim 11, Farmer** teaches "means for creating the workflow." (paragraphs 0049, 0050)



**As per claim 12, Farmer** teaches “the storage means resides locally with the client.” (paragraphs 0039, 0044)

**As per claim 13, Farmer** teaches “means for collecting and storing available Web services data in said storage means.” (paragraphs 0018, 0022)

**As per claim 14, Farmer** teaches “a system for inputting sequence data into the workflow execution.” (paragraph 0067)

**As per claim 16, Farmer** teaches “A method for executing a bioinformatics workflow from a client on the World Wide Web,” (see Abstract and paragraph 0008)

“comprising: providing a workflow having a plurality of linked tasks and a specified input and output format;” (Figure 3, paragraphs 0040, 0042, 0043, 0045, 0046, 0053, 0062, wherein services interact and identify with each other through java classes, and are encapsulated to interact with each other, including formats defined by type signatures)

“providing a list of known bioinformatics Web services, wherein each listed Web service includes a description of a task performed by the Web service, and an input signature and an output signature of the Web service, further wherein the Web service comprises a computer program accessible over the World Wide Web;” (Figure 3, paragraphs 0018, 0022, 0022, 0051, 0057, 0058, 0062, wherein a Service Broker accepts requests and provides connections to services, and contains service names, types, and attributes in Java class format, including type signatures)

"selecting a Web service from the list of known bioinformatics Web services for each task in the bioinformatics workflow to form a chain of Web services, wherein the selecting step examines a set of available Web services capable of completing each task and identifies at least one Web service having matching input and output signatures ensuring that each Web service selected to complete a task is compatible with adjacent Web services in the chain of Web services" (Figure 3, Figure 11, paragraphs 0022, 0036, 0041, 0043, 0046, 0048, 0049, 0056, 0057, 0058, 0061, 0070, 0071, 0074-0079, wherein services are provided by service providers, and a client can utilize dynamic discovery to identify services that can recognize the data type to complete the service, to integrate heterogeneous data components and services).

"and calling each selected Web service in the chain to execute the bioinformatics workflow." (Figure 11, paragraphs 0040, 0053, 0060, 0061, 0062, 0063, wherein services can be linked together and service attributes and classes are used for interaction)

**As per claim 17, Farmer** teaches "the bioinformatics workflow comprises a microarray analysis." (Figure 2, paragraphs 0049, 0086)

**As per claim 18, Farmer** teaches "the list of known bioinformatics Web services resides locally to the client." )(paragraphs 0039, 0044)

**As per claim 20, Farmer** teaches "the step of calling each selected Web service includes the step of providing a set bioinformatics data to a first Web service in the chain in the specified input format." (paragraph 0067)

***Claim Rejections - 35 USC § 103***

9. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

10. Claims 7, 15, and 19 rejected under 35 U.S.C. 103(a) as being unpatentable over Farmer (WO 02/39486) in view of Yung et al. (US Patent 6,909,974 B2)

**As per claim 7, Farmer** is disclosed as per claim 1 above. Farmer does not teach “the input signature comprises a FASTA XML format for a set of input sequences and the output signature comprises an XML file format for providing spatial microarray placement data.”

Yung teaches “the input signature comprises a FASTA XML format for a set of input sequences and the output signature comprises an XML file format for providing spatial microarray placement data.” (Figure 10, 12A, 12B, 13, column 12 line 20 – column 13 line 2, column 19 line 60 – column 20 line 12, wherein XML format is used to wrap information and provide communication between heterogeneous services in a bioinformatics system, particularly XML input and output files).

It would have been obvious to one of ordinary skill in the art to combine Farmer's method of allowing interoperation of heterogeneous bioinformatics software services with Yung's ability to utilize XML formatted files in communicating between different

services linked in a workflow. This gives the user the ability to use XML when inputting and outputting bioinformatics data in a workflow to provide the user of a bioinformatics system a commonly used communication format, XML, and allows the user to define the tags that identify attributes. The motivation for doing so would be to provide a centralized biological information flow management system that requires less human involvement and the possibility of error than previous systems (column 1 lines 44-63)

**As per claim 15, Farmer** is disclosed as per claim 1 above. Farmer does not teach “the input signature comprises a FASTA XML format for a set of input sequences and the output signature comprises an XML file format for providing spatial microarray placement data.”

Yung teaches “the input signature comprises a FASTA XML format for a set of input sequences and the output signature comprises an XML file format for providing spatial microarray placement data.” (Figure 10, 12A, 12B, 13, column 12 line 20 – column 13 line 2, column 19 line 60 – column 20 line 12, wherein XML format is used to wrap information and provide communication between heterogeneous services in a bioinformatics system, particularly XML input and output files).

It would have been obvious to one of ordinary skill in the art to combine Farmer's method of allowing interoperation of heterogeneous bioinformatics software services with Yung's ability to utilize XML formatted files in communicating between different services linked in a workflow. This gives the user the ability to use XML when inputting and outputting bioinformatics data in a workflow to provide the user of a bioinformatics

system a commonly used communication format, XML, and allows the user to define the tags that identify attributes. The motivation for doing so would be to provide a centralized biological information flow management system that requires less human involvement and the possibility of error than previous systems (column 1 lines 44-63)

**As per claim 19, Farmer** is disclosed as per claim 1 above. Farmer does not teach “the input signature comprises a FASTA XML format for a set of input sequences and the output signature comprises an XML file format for providing spatial microarray placement data.”

Yung teaches “the input signature comprises a FASTA XML format for a set of input sequences and the output signature comprises an XML file format for providing spatial microarray placement data.” (Figure 10, 12A, 12B, 13, column 12 line 20 – column 13 line 2, column 19 line 60 – column 20 line 12, wherein XML format is used to wrap information and provide communication between heterogeneous services in a bioinformatics system, particularly XML input and output files).

It would have been obvious to one of ordinary skill in the art to combine Farmer's method of allowing interoperation of heterogeneous bioinformatics software services with Yung's ability to utilize XML formatted files in communicating between different services linked in a workflow. This gives the user the ability to use XML when inputting and outputting bioinformatics data in a workflow to provide the user of a bioinformatics system a commonly used communication format, XML, and allows the user to define the tags that identify attributes. The motivation for doing so would be to provide a

centralized biological information flow management system that requires less human involvement and the possibility of error than previous systems (column 1 lines 44-63).

### ***Response to Arguments***

11. Applicant's arguments, see page 8, filed 7/29/2008, with respect to the rejection of claims 1-20 under 35 USC 102(b) have been fully considered but they are not persuasive. Details are stated below.

a. Examiner is entitled to give claim limitations their broadest reasonable interpretation in light of the specification. See MPEP 2111 [R-I]

#### **Interpretation of Claims-Broadest Reasonable Interpretation**

During patent examination, the pending claims must be 'given the broadest reasonable interpretation consistent with the specification.' Applicant always has the opportunity to amend the claims during prosecution and broad interpretation by the examiner reduces the possibility that the claim, once issued, will be interpreted more broadly than is justified. In re Prater, 162 USPQ 541,550-51 (CCPA 1969).

b. Applicant's argument is stated as Farmer does not teach wherein the selecting system examines a set of available Web services capable of completing each task and identifies at least one Web service having matching input and output signatures ensuring that each Web service selected to complete a task is compatible with adjacent Web services in the chain of Web services.

In regards to this argument, Examiner respectfully disagrees. As stated in the above 102(b) rejection, Farmer discloses that services are provided by service providers (paragraph 0046) and a client can utilize dynamic discovery to identify services that can recognize the data type to complete the service (paragraphs 0048, 0049), for the integration of heterogeneous data components and services in a chain of services. As stated in paragraph 0049, the service providers receive and analyze data objects that are sent to it, and if it recognizes the type and can execute it, a service object is created to complete the service. As previously stated, Farmer discloses that services can be linked together and service attributes and classes are utilized to complete a search using various heterogeneous data components. For purposes of examination, examiner interprets the input and output signature of the instant application to be the specific format that a service receives and sends out once it is analyzed, to assure that data passing through a linked series of services is compatible. This is accomplished through mapping of data and attributes, as disclosed in paragraphs 000057, 0058, and 0059, with a specific example briefly mentioned in paragraph 0060, and further discussed in Figure 11 and paragraphs 0070, 0071, and 0074-0079, wherein a data model is disclosed that maps out the various systems and subsystems, and how they are linked together. By utilizing service providers and passing information wrapped with a simple java class (as disclosed in the previous office action), objects are passed between service providers and relevant services from the service providers are identified by the system.

Therefore, Farmer discloses the selecting system examines a set of available Web services capable of completing each task and identifies at least one Web service having matching input and output signatures ensuring that each Web service selected to complete a task is compatible with adjacent Web services in the chain of Web services.

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to DANGELINO N. GORTAYO whose telephone number is (571)272-7204. The examiner can normally be reached on M-F 7:30-4:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Tim T. Vo can be reached on (571)272-3642. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



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/Dangelino N. Gortayo/  
Examiner, Art Unit 2168

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